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10/537,277	05/27/2005	Yoshio Onoda	086590-0012	2231
20277 7590 03/02/2011 MCDERMOTT WILL & EMERY LLP 600 13TH STREET, N.W. WASHINGTON, DC 20005-3096				
EXAMINER				
WALKER, NED ANDREW				
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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/537,277

Applicant(s)

ONODA, YOSHIO

Examiner

NED A. WALKER

Art Unit

3781

Period for Reply -- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 18 November 2010.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-17 and 20-22 is/are pending in the application.
- 4a) Of the above claim(s) 3-17 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-2 and 20-22 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 15 October 2010 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftperson's Patent Drawing Review (PTO-946)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

DETAILED ACTION

Drawings

1. The new drawings were received on August 5th, 2008 and October 15th, 2010.

These drawings are not acceptable because:

- The replacement drawing sheets filed October 15th, 2010 failed to fully overcome the objections detailed in the Final Rejection mailed August 17th, 2010. The objections that have not overcome are reiterated in the paragraphs below.
 - The replacement drawing sheets filed October 15th, 2010 include new matter. See the new matter objection detailed under the Specification section herein for further explanation.
 - The Examiner has discovered previously undocumented objections in the Drawings filed August 5th, 2008 which are also present in the newly filed Drawings of October 15th, 2010. The Examiner apologizes for the unintended piecemeal prosecution of this issue; however, these objections were not previously raised because of an honest oversight on the part of the Examiner and must now be documented since they have brought to the Examiner's attention. These objections are detailed in the following paragraphs.
2. New corrected drawings in compliance with 37 CFR 1.83(a), 37 CFR 1.84, and 37 CFR 1.121 are required in this application because:

The drawings are objected to under 37 CFR 1.83(a). The drawings must show every feature of the invention specified in the claims. Therefore, "a portion of said seal

face part" must be shown or the feature(s) canceled from the claim(s). No new matter should be entered.

The drawings are objected to under 37 CFR 1.83(a) because they fail to show "a portion of said seal face part contacts said container above the seam part and below the top face" as described in Claim 1. Any structural detail that is essential for a proper understanding of the disclosed invention should be shown in the drawing. MPEP § 608.02(d).

The view numbers are improperly titled using the designation "Figure" instead of "FIG." View numbers must be preceded by the abbreviation "FIG." Refer to 37 CFR 1.84(u)(1). See Replacement Drawing Sheets filed August 5th, 2008: Figure(s) 1A-15 and Replacement Drawing Sheets filed October 15th, 2010 Figure(s) 2A-2C, 4A, and 4B.

The figures improperly depict moved positions or changes to features. A moved position may be shown by a broken line superimposed upon a suitable view within one view if this can be done without crowding; otherwise, a separate view must be used for this purpose. Refer to 37 CFR 1.84(h(4)). See Replacement Drawing Sheets filed August 5th, 2008: Figure(s) 2A and 6A-6D and Replacement Drawing Sheets filed October 15th, 2010 Figure(s) 2A.

The figures are improperly numbered since the figures contain multiple views within one figure. The different views must be numbered in consecutive Arabic numerals, starting with 1, independent of the numbering of the sheets and, if possible, in the order in which they appear on the drawing sheet(s). Refer to 37 CFR 1.84(u). See

Replacement Drawing Sheets filed August 5th, 2008: Figure(s) 2A and 6A-6D and
Replacement Drawing Sheets filed October 15th, 2010 Figure(s) 2A.

3. Corrected drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. The figure or figure number of an amended drawing should not be labeled as "amended." If a drawing figure is to be canceled, the appropriate figure must be removed from the replacement sheet, and where necessary, the remaining figures must be renumbered and appropriate changes made to the brief description of the several views of the drawings for consistency. Additional replacement sheets may be necessary to show the renumbering of the remaining figures. Each drawing sheet submitted after the filing date of an application must be labeled in the top margin as either "Replacement Sheet" or "New Sheet" pursuant to 37 CFR 1.121(d). If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

Applicant is advised to employ the services of a competent patent draftsman outside the Office, as the U.S. Patent and Trademark Office no longer prepares new drawings. The corrected drawings are required in reply to the Office action to avoid abandonment of the application. The requirement for corrected drawings will not be held in abeyance.

Specification

4. The specification is objected to as failing to provide proper antecedent basis for the claimed subject matter (37 CFR 1.75(d)(1) and MPEP §608.01(o)) with respect to the Amendment filed May 19th, 2010. Correction of the following is required:

Amended Claim 1 comprises the limitation "a portion of said seal face part contacts said container *above the seam part and below the top face*" (emphasis added).

5. The amendment filed October 15th, 2010 is objected to under 35 U.S.C. 132(a) because it introduces new matter into the disclosure. 35 U.S.C. 132(a) states that no amendment shall introduce new matter into the disclosure of the invention. The added material which is not supported by the original disclosure is as follows:

Drawings

- The specific designation of "the top face 100" as the particular feature identified by the reference line in FIGS. 2C, 4A, 4B. No previous indication in the original disclose was given that this particular feature in the illustration constituted the top face; furthermore, this feature was not identified in the original Claims and is now a supposed critical feature yet it was not previously distinguished.

Specification

- The added limitation to the Specification reciting "the cap 10 contacts the container above the seam part and below the top face" lacks support in the original disclosure. The Examiner notes that the original disclosure (e.g. FIG. 4) illustrates the cap contacting the container but

it is not clear which part of the container constitutes "the top face."

There is no support from the original disclosure that the cap contacts the container "below the top face"; the original Drawings do not provide support because the top face was not specifically designated and could have been conceivable any part of feature of the container.

- The specific designation of "the top face" as the feature "100" which is designated as a specific feature in the newly amended Drawings constitutes new matter. No previous indication in the original disclose was given that this particular feature in the illustration constituted the top face; furthermore, this feature was not identified in the original Claims and is now a supposed critical feature yet it was not previously distinguished.

6. Applicant is required to cancel the new matter in the reply to this Office Action.

Claim Rejections - 35 USC § 112

7. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

8. Claims 1, 2, and 20-22 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. Specifically, the amendment filed

May 19th, 2010 comprises the limitation "a portion of said seal face part contacts said container *above the seam part and below the top face*" (emphasis added) as amended in Claim 1. The Examiner could not find support for this limitation in the originally filed disclosure.

Claims 1 is rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention. Specifically, the amendment filed May 19th, 2010 comprises the limitation "a portion of said seal face part contacts said container *above the seam part and below the top face*" (emphasis added) as amended in Claim 1.

9. Claims 2 and 20-22 are rejected for incorporating the errors from their respective parent claim by dependency.

Claim Rejections - 35 USC § 102

10. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

11. Claims 1, 20, and 22 are rejected under 35 U.S.C. 102(b) as being anticipated by Roth (US Pat. No. 2,266,270).

Roth discloses a cap (FIG. 5) disposed around a lid of a container (32) for canned drinks comprising: a seal face part (20) made as a film to expand and contract

and covers a top face of said container for canned drinks (FIG. 5); an outer-perimeter part (21) being an elastic material to expand and contract (column 1 lines 48-50) and is disposed on an outer perimeter of said seal face part (FIG. 5), said outer-perimeter part having a cross-sectional composition that is configured and arranged to couple with a recess below a seam part of said container (FIG. 5); wherein an entire top face of said container for canned drinks is covered in a water-tight manner by said seal face by attaching said outer-perimeter part below a seam part of said container thereby removably and replaceably self-sealing said cap to said container for canned drinks (FIG. 5); wherein a thickness of said seal face part is less than a thickness of said outer-perimeter part (FIG. 5); and wherein a portion of said seal face part contacts said container above the seam part and below the top face (FIG. 5 capable); wherein said outer-perimeter part has a cross-sectional compositional shape that is circular (FIG. 5); wherein said seal face part is configured and arranged to deform to a bottom of said container for canned drinks to permit stacking of said container (FIG. 5 capable).

Claim Rejections - 35 USC § 103

12. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

13. The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

14. Claims 2 and 21 are rejected under 35 U.S.C. 103(a) as being obvious over Roth (US Pat. No. 2,266,270).

Roth, as applied to claim 1 above, teaches substantially all the limitations of the claim except wherein said seal face part and outer-perimeter part are made of at least one of polystyrene and polypropylene by injection molding as one unit; a thickness of said seal face part is equal to 0.4 mm or less; and a thickness of said outer-perimeter part is equal to 0.5 mm or greater; wherein said seal face part has an expansion ratio of about 1:1.14.

It would have been obvious to one having ordinary skill in the art at the time the invention was made to have the parts made of at least one of polystyrene and polypropylene by injection molding as one unit, since it has been held to be within the general skill of a worker in the art to select a known material on the basis of its suitability for the intended use as a matter of obvious design choice (*In re Leshin*, 125 USPQ 416. See also *Ballas Liquidating Co. v. Allied industries of Kansas, Inc.* (DC Kans) 205 USPQ 331).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to use such thickness ranges, since it has been held that where the general conditions of a claim are disclosed in the prior art, discovering the optimum or workable ranges involves only routine skill in the art (*In re Aller*, 105 USPQ 233).

It would have been obvious to one having ordinary skill in the art at the time the invention was made to design the seal face part to have an expansion ratio of about 1:1.14, since it has been held that discovering an optimum value of a result effective variable involves only routine skill in the art (*In re Boesch*, 617 F.2d 272, 205 USPQ 215 (CCPA 1980)).

Response to Amendment

15. The amendment filed October 15th, 2010 is objected to under 35 U.S.C. 132(a) because it introduces new matter into the disclosure. 35 U.S.C. 132(a) states that no amendment shall introduce new matter into the disclosure of the invention. The added material which is not supported by the original disclosure is as follows:

Drawings

- The specific designation of “the top face 100” as the particular feature identified by the reference line in FIGS. 2C, 4A, 4B. No previous indication in the original disclose was given that this particular feature in the illustration constituted the top face; furthermore, this feature was not identified in the original Claims and is now a supposed critical feature yet it was not previously distinguished.

Specification

- The added limitation to the Specification reciting "the cap 10 contacts the container above the seam part and below the top face" lacks support in the original disclosure. The Examiner notes that the original disclosure (e.g. FIG. 4) illustrates the cap contacting the container but it is not clear which part of the container constitutes "the top face." There is no support from the original disclosure that the cap contacts the container "below the top face"; the original Drawings do not provide support because the top face was not specifically designated and could have been conceivable any part of feature of the container.
- The specific designation of "the top face" as the feature "100" which is designated as a specific feature in the newly amended Drawings constitutes new matter. No previous indication in the original disclosure was given that this particular feature in the illustration constituted the top face; furthermore, this feature was not identified in the original Claims and is now a supposed critical feature yet it was not previously distinguished.

16. Applicant is required to cancel the new matter in the reply to this Office Action.

Response to Arguments

17. Applicant's arguments, see amendment filed October 15th, 2010, with respect to the objection to the Drawings and Specification have been considered in view of the amendment to Drawings and Specification, have been fully considered, but are not persuasive; the amendment is insufficient in overcoming the objections.

Issues of new matter notwithstanding, it is unclear as to how the designation of the "top face 100" as now illustrated in FIGS. 2C, 4A, and 4B would transfer to the cited support of FIG. 6B as specifically required by Claim 1 and as shown in the Applicant's annotated FIG. 6B shown on the top of page 11 of the aforementioned amendment. Specifically, as purported by the Applicant in the new figures, the top face would be present in the same general vicinity as the seam part and not on the upper most portion of the annotated FIG. 6B as purported by the Applicant. There is no support for this or evidence of such an interpretation; furthermore, the two depictions conflict with one another. The previously applied objection with respect to the top face remains.

18. Applicant's arguments, see amendment filed October 15th, 2010, with respect to the rejection of Claims 1, 2, and 20-22 under 35 USC §112, first paragraph, have been fully considered, but are not persuasive.

Firstly, the required disclosure has not been met because the Applicant amended the Specification to include "the cap 10 contacts the container above the seam part and below the top face" which does not provide support for "*a portion of said seal face part* contacts said container above the seam part and below the top face" (emphasis added).

Furthermore, it remains unclear as to how the contact would be "above the seam part and below the top face" even with the top face being depicted as 100 in FIGS. 2C, 4A, and 4B because that would mean that the contact would still exist above the top face according to FIG. 6B. The change in position of the top face as argued by the Applicant in the aforementioned amended 6B is inconsistent and lacks support for this

alternative interpretation. See the response to the drawing/specification, *supra*.

Therefore there remains a lack of enablement and required written description.

19. Applicant's arguments, see amendment filed October 15th, 2010, with respect to the rejection of Claims 1, 20, and 22 under 35 USC §102(b) as being anticipated by Roth (US Pat. No. 2,266,270) and Claims 2 and 21 under 35 U.S.C. 103(a) as being obvious over Roth (US Pat. No. 2,266,270), have been fully considered, but are not persuasive.

In response to applicant's arguments, the recitation of "a lid of a container," has not been given patentable weight because the recitation is functionally introduced in the preamble language "[a] cap disposed around a lid of container." Therefore, all subsequent structure given to the container and/or lid has been treated similarly along with any relationships such structure may have with seal face part or outer perimeter part. A preamble is generally not accorded any patentable weight where it merely recites the purpose of a process or the intended use of a structure, and where the body of the claim does not depend on the preamble for completeness but, instead, the process steps or structural limitations are able to stand alone. See *In re Hirao*, 535 F.2d 67, 190 USPQ 15 (CCPA 1976) and *Kropa v. Robie*, 187 F.2d 150, 152, 88 USPQ 478, 481 (CCPA 1951).

In response to applicant's argument that Roth does not anticipate "a portion of said seal face part contacts said container above the seam part and below the top face" is unconvincing. The Applicant is reminded he is merely arguing functional language and not positive structural limitations. The presence of process limitations on product

claims, wherein the product does not otherwise patentably distinguish over the prior art, cannot impart patentability to the product. *In re Stephens* 145 USPQ 656 (CCPA 1965). While features of an apparatus may be recited either structurally or functionally, claims directed to an apparatus must be distinguished from the prior art in terms of structure rather than function. *In re Schreiber*, 128 F.3d 1473, 1477-78, 44 USPQ2d, 1429, 1431-.2 (Fed. Cir. 1997); *see also In re Swinehart*, 439 F.2d 210, 212-13, 169 USPQ 226, 228-29 (CCPA 1971); *In re Danly*, 263 F.2d 844, 847, 120 USPQ 528, 531 (CCPA 1959). “[A]pparatus claims cover what a device *is*, not what a device *does*.” *See Hewlett-Packard Co. v. Bausch & Lomb Inc.*, 909 F.2d 1464, 1469, 15 USPQ2d 1525, 1528 (Fed. Cir. 1990) (original emphasis). A claim containing a “recitation with respect to the manner in which a claimed apparatus is intended to be employed does not differentiate the claimed apparatus from a prior art apparatus” if the prior apparatus teaches all the structural limitations of the claims. *Ex parte Masham*, 2 USPQ 2d 1647 (Bd. Pat. App. & Inter. 1987).

In this instant case the crowned disk is capable of attaching to a container design according to the claims and is capable of achieving the aforementioned relationships. The Applicant is reminded that the Examiner is not bound by the particular container depicted in the reference or its relationship thereto because the associated limitations in the instant application are only functionally claimed; therefore the Examiner need only consider the structure of the cap depicted in the reference and whether or not this structure is capable of fitting the particular container functionally claimed in the instant application. Furthermore, the Examiner is not bound by the method of use in the

reference and therefore losing the "crowned" feature or its elimination of air is of no consequence. Again, the structure of the cap meets the limitations of the instant application.

In response to Applicant's argument that the reference includes additional structure and/or function not required by Applicant's invention, it must be noted that the reference discloses the invention as claimed. The fact that the prior art discloses additional structure and/or function that is not claimed is irrelevant in determining anticipation. "The use of patents as references is not limited to what the patentees describe as their own inventions or to the problems with which they are concerned. They are part of the literature of the art, relevant for all they contain." *In re Heck*, 699 F.2d 1331, 1332-33, 216 USPQ 1038, 1039 (Fed. Cir. 1983) (quoting *In re Lemelson*, 397 F.2d 1006, 1009, 158 USPQ 275, 277 (CCPA 1968)).

20. For these reasons, the objection to the Drawings and Specification, the rejection of Claims 1, 2, and 20-22 under 35 USC §112, first paragraph, and the rejection of Claims 1, 20, and 22 under 35 USC §102(b) as being anticipated by Roth (US Pat. No. 2,266,270) and Claims 2 and 21 under 35 U.S.C. 103(a) as being obvious over Roth (US Pat. No. 2,266,270), are hereby affirmed.

Conclusion

21. Any inquiry concerning this communication or earlier communications from the examiner should be directed to NED A. WALKER whose telephone number is (571)270-3545. The examiner can normally be reached on Mon. - Fri. 7:30 AM - 5:00 PM EST.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Anthony Stashick can be reached on 571-272-4561. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Anthony Stashick/
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NW